Supreme Court, U.S.
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No. 87-674

IN THE SUPREME COURT OF THE UNITED STATES

OCTOBER TERM 1987

THE MIHALEK CORPORATION AND LAWRENCE PATRICK MIHALEK, Petitioners

v

THE STATE OF MICHIGAN, GOVERNOR JAMES J. BLANCHARD, THE DEPARTMENT OF COMMERCE OF THE STATE OF MICHIGAN, RALPH J. GERSON, Director, ROSS ROY, INC., Respondents

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SUPPLEMENTAL BRIEF
RULE 22.6

PETITION FOR A WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE SIXTH CIRCUIT

James M. Deimen, Ph.D., J.D.
Counsel of Record for Petitioners
Patent, Trademark and Copyright Attorney
Professional Engineer
Burlington Office Center, Suite Two
325 East Eisenhower Parkway
Ann Arbor, Michigan 48108-3397
(313) 994-5947

QUESTIONS PRESENTED

1. Are a State of the United States, its political subdivisions, their employees, officers and officials, when sued for money damages and injunctive relief for copyright infringement in violation of the Copyright Act of 1976, entitled to immunity under the Eleventh Amendment to the United States Constitution?

2. Are intellectual property rights considered a property under the Fifth Amendment taking clause of the United States Constitution?

3. What are the standards of the tests for copyright infringement, the taking of intellectual property under the Fifth Amendment and false designation of origin, section 43(a) of the Lanham Act (15 U.S.C. 1125(a)), involving a State of the United States, its political subdivisions, and their employees, officers and officials?

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Pursuant to Supreme Court Rule 22.6, counsel requests consideration of the following Supplemental Brief. On October 22, 1987, counsel discovered a case

entitled Williams v Baxter (hereinafter called Baxter), 812 F2d 421 (CA 9, 1987), 2 USPQ2d 1059, Supreme Court Docket Number 87-491, as cited in The United States Law Week, Supreme Court Proceedings, Volume 56, Number 14, page 56LW 3271, dated October 13, 1987. The Baxter petition for a writ of certiorari to the United States Court of Appeals for the Ninth Circuit was filed with this Court on September 19, 1987. It appears to raise the important federal question of the proper substantial similarity test for copyright infringement (Copyright Act 17 U.S.C.) to be applied to a motion for summary judgment pursuant to Federal Rule of Civil Procedure 56.

In Mihalek Corp. et al. v Michigan et al. (hereinafter called Mihalek), 595 F. Supp. 903 (E.D. Mich 1984), 630 F. Supp. 9 (E.D. Mich 1985), 814 F.2d 290 (6th Cir. 1987), Supreme Court Docket Number _____, filed September 6, 1987, there is a direct conflict with the Baxter case. This conflict between the decisions of the Sixth Circuit and the Ninth Circuit, in the Mihalek and

Baxter cases, involves the test of whether or not the granting or denying of a motion for summary judgment under Rule 56 depends upon the response of the District Court Judge or the response of an ordinary lay person to the evidence.

Both the Mihalek and Baxter cases are "on all fours" involving the following:

1) both cases relied on Sid & Marty Krofft Television Productions, Inc. v McDonald's Corp., 562 F.2d 1157 (9th Cir. 1977) as the controlling authority;

2) both cases exhibit duly registered and owned copyrights;

3) in both cases access was established and admitted by defendants;

4) in both cases the general ideas were substantially similar.

In the Baxter case, the Ninth Circuit reversed the District Court's summary judgment and remanded for trial not inconsistent with its opinion. In the Mihalek case, the Sixth Circuit affirmed the District Court's summary judgment.

The major difference in the Mihalek and Baxter cases, if any, is that Mihalek presented nine affidavits of "average lay observers" and the proposed testimony of an additional twelve witnesses in Mihalek's unsuccessful attempt to defeat Respondent's motion for summary judgment. In the Baxter case, Baxter argued that he should have been permitted to prove copyright infringement by way of expert testimony, see Baxter, 424 (footnote 2). Baxter defeated the motion for summary judgment apparently without the assistance of average lay observers.

In addition, in the Mihalek case there was also exhibited the direct copying of the document under copyright registration number TXu-139-833. The document was presented to the District Court six times during briefing and oral argument and eight times to the Court of Appeals. By definition, the copies are not only substantially similar, they are identical. It should be noted that in the Mihalek case, there are four copyright registrations involved, copyright registration numbers

TXu 139-832, Txu 139-833, PAu 557-097 and VAu 53-133. These registrations of copyright represent approximately 110 works, which were formed into a collective package exhibiting the factual narration, structuring of material and the marshaling of facts telling the promotional story about the State of Michigan. In the Baxter case, there appears to be only one copyright registration involved. See Baxter, page 422, footnote 1.

This conflict between the two circuits as a matter of law and involving a substantial federal question (Supreme Court Rule 17.1a, c) is clear as follows:

Baxter, 812 F.2d 421, 424 (9th Cir. 1987)

> ". . .Summary judgment cannot be granted if there exists a genuine dispute as to a material fact. Fed.R.Civ.P. 56(c). Rule 56 calls for the judge to determine whether there exists a genuine issue for trial, not to weigh the evidence himself and determine the truth of the matter. See Anderson v Liberty Lobby, Inc., ____ U.S. ____, 106 S.Ct. 2505, 2516, 91 L.Ed.2d 202 (1986). The nonmoving party must present evidence sufficient to require a jury or judge to resolve the parties' differing versions of the truth at trial. First National Bank of Arizona v Cities Service Co., 391 U.S. 253, 288-289, 88 S. Ct. 1575, 1592, 20 L.Ed.2d

569 (1968). Inferences to be drawn from facts contained in the moving party's papers are to be viewed by the district court in the light most favorable to the non-moving party. See Adickes v S.H. Kress & Co., 398 U.S. 144, 90 S.Ct. 1598, 26 L.Ed.2d 142 (1970). Weighing evidence, determining credibility, and drawing inferences from facts remain jury functions which may not be undertaken by the trial judge. See Anderson, 106 S.Ct. at 2513.

Determinations of substantial similarity of expression are subtle and complex. The test to be applied has been labeled an "intrinsic" one by this Court in that it depends not upon external criteria, but instead upon the response of the ordinary reasonable person to the works. Krofft, 562 F.2d at 1164. "Analytic dissection" and expert testimony are not called for; the gauge of substantial similarity is the response of the ordinary lay hearer. Id., quoting Arnstein v. Porter, 154 F.2d 464 (2d Cir. 1946), cert. denied, 330 U.S. 851, 67 S.Ct. 1096, 91 L.Ed. 1294 (1946). Accordingly, in Krofft, this court rejected extrinsic analysis of similarities and difference among characters in plaintiff's television show and defendants' TV commercials, in favor of asking whether the defendants' works captured the total concept and feel of plaintiffs' works. Krofft, 562 F.2d at 1167. See also Berkic, 761 F.2d at 1292; Litchfield v. Spielberg, 736 F.2d 1352, 1357 (9th Cir. 1984), cert. denied, 470 U.S. 1052, 105 S.Ct. 1753, 84 L.Ed.2d 817 (1985); Overman v. Universal City Studios, Inc., 605 F.Supp. 350, 353 (C.D.Cal. 1984), aff'd mem. 767 F.2d 933 (9th Cir. 1985). . .." (Emphasis added).

and in Mihalek, 814 F.2d 290, 294 (6th Cir. 1987)

> ". . .In this case the works, materials and expressions of Mihalek as compared with those utilized in the State's campaign are crucial and determinative, not the opinions of lay observers, who have made no careful determinations of the entire concepts involved.[2] See Wickham, 739 F.2d at 1097; Decorative Aides Corp. v. Staple Sewing Aides Corp., 497 F.Supp. 154, 157 (S.D.N.Y. 1980), aff'd mem., 657 F.2d 262 (2d Cir. 1981); Clarke, 472 F.Supp. at 482. All this pertinent evidence was before the district court to be examined as to the materials in dispute. We are unable to say the materials raised a genuine issue of material fact as to substantial similarity, even giving plaintiffs the benefit of all favorable inferences to be drawn. . ..
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> . . .The fact that plaintiffs envisioned a promotional campaign featuring the use of tee shirts, hats, slogans, pictures, and promotional events, and that the campaigns utilized by the State of Michigan incorporated these generally universal ideas, among many many other devices, in a public relations program to spotlight affirmative things about the State of Michigan is not any indication of similarity where the individual clothing items, slogans, pictures and events were substantially different. . .." (Emphasis added.)

and in Baxter, 812 F.2d 421, 424 (9th Cir. 1987)

> ". . .Accordingly, in Krofft, this court rejected extrinsic analysis of similarities and difference among characters in plaintiff's television show and defendants' TV

commercials, in favor of asking whether the defendants' works captured the total concept and feel of plaintiffs' works. Krofft, 562 F.2d at 1167. . .." (Emphasis added.)

and in Mihalek, 630 F.Supp. 9, 14, 15 (E.D. Mich 1984)

". . .As the court's ruling on the motion for summary judgment indicates, the court further found that there could be no genuine question of material fact on this issue.

In coming to this conclusion, the court did not and could not take into consideration the affidavits filed by plaintiff, representing the conclusions of purported average lay observers, that the two sets of works were substantially similar. . ..

. . .Finally and most fundamentally, the affidavits are an irrelevant form of evidence for the purposes of the issue presented by the defendant's motion. As indicated above, the question of whether or not there exists a genuine question of material fact with respect to the issue of substantial similarity is one of law for the court. The proper inquiry is whether or not a hypothetical jury, impaneled in this case and presented with plaintiff's proofs of infringement, could reasonably conclude that the two sets of works were substantially similar. The court must, in effect, set the minimum legal standard for submission of the case for jury deliberation.

Taken in a manner most favorable to the plaintiff, the affidavits can be construed to indicate that the affiants themselves believe that there is a substantial similarity between the two bodies of works. But the affiants can not substitute their judgment for that of the court with respect to establishing the minimum standard. . .at 14.

. . .If plaintiff sought to introduce additional testimentary evidence that certain persons who viewed both plaintiff's works and defendants' campaigns believed that substantial similarity existed between the two, that testimony would have been irrelevant, for the reasons set forth supra regarding plaintiff's affidavits on this score. . .at 15.

. . .In so doing, the court found that the defendant did not take

> from plaintiff's works so much of what is pleasing to the eyes and ears of lay persons who comprise the audience for whom such popular works are composed, (so) that defendant wrongfully appropriated something which belongs to plaintiff. . .at 15." (Emphasis added).

and in Baxter, 812 F.2d 421, 424 (9th Cir. 1987)

". . .the gauge of substantial similarity is the response of the ordinary lay hearer. Id., quoting Arnstein v. Porter, 154 F.2d 464 (2d Cir. 1946), cert. denied, 330 U.S. 851, 67 S.Ct. 1096, 91 L.Ed. 1294 (1946). . .." (Emphasis added.)

It is Mihalek's position that the minimum legal standards are set by Rule 56 of the Federal Rules of Civil Procedure. The standards are clearly reaffirmed in Anderson v. Liberty Lobby, Inc., ____ U.S. ____, 106 S.Ct. 2505, 2516, 91 L.Ed.2d 202 (1986) and Baxter. Summary judgment in the Mihalek case is therefore not in accord with established law.

CONCLUSION

A review of the complete record by this Court will confirm that Mihalek has not been decided by the lower courts in accordance with established law. This counsel on October 14, 1987, requested the entire record be certified and transmitted, pursuant to Supreme Court Rule 19.1. The petition for a writ of certiorari should be granted for briefing and oral argument for reasons of substantial federal questions of public importance and ongoing conflicts among the various circuits on the Questions Presented by the Mihalek Petition.

In the alternative the Mihalek petition should be granted and simultaneously a Writ of Mandamus to the United States Court of Appeals for the Sixth Circuit issued ordering decision on the First Question presented (Eleventh Amendment) in ninety days (already briefed and argued). And by Summary Action reverse and remand back to the District Court for trial not inconsistent with Anderson v. Liberty Lobby, Inc., supra, Baxter, supra, Krofft, supra and Perry v. Sindermann, 408 U.S. 593, 33 L.Ed.2d 570, 92 S.Ct. 2694 (1972) the summary judgment dispositions raised in the Second and Third Questions presented in the Mihalek petition.

October 29, 1987 Respectfully submitted,

/s/ JAMES M. DEIMEN
James M. Deimen (P 12635)
325 E. Eisenhower Pkwy., Ste. Two
Ann Arbor, MI 48108-3397
(313) 994-5947

COUNSEL OF RECORD
FOR PETITIONERS